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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,267	10/13/2000	Jeffrey Glenn	240042052403	1206
7	590 03/04/2002			
MORRISON AND FOERSTER LLP			EXAMINER	
3811 VALLEY CENTER DR. Suite 500			BRUMBACK, BRENDA G	
San Diego, CA	92130-3310		ART UNIT	PAPER NUMBER
	1		1642	
•			DATE MAILED: 03/04/2002	2
	1			

Please find below and/or attached an Office communication concerning this application or proceeding.

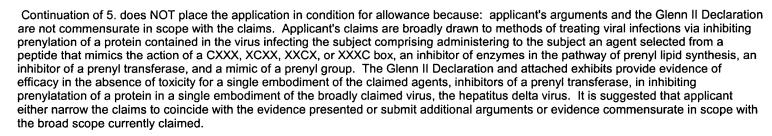
## **Advisory Action**

Application No.	Applicant(s)
09/687,267	GLENN, JEFFREY
Examiner	Art Unit
Brenda G. Brumback	1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

Examination (RCE) in compliance with 37 CFR 1.114.	
PERIOD FOR REPLY [check either a) or b)]	
<ul> <li>a)</li></ul>	ection.
To6.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the algorithm fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The affee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the fit (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final retimely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).	appropriate extension nal Office action; or
1. A Notice of Appeal was filed on Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.	
2. The proposed amendment(s) will not be entered because:	
(a) they raise new issues that would require further consideration and/or search (see NOTE below	·);
(b) ☐ they raise the issue of new matter (see Note below);	
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or issues for appeal; and/or	simplifying the
(d) they present additional claims without canceling a corresponding number of finally rejected cla	ims.
NOTE:	
3. Applicant's reply has overcome the following rejection(s):	
4. Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely file canceling the non-allowable claim(s).	ed amendment
5. ☑ The a) ☐ affidavit, b) ☐ exhibit, or c) ☑ request for reconsideration has been considered but does N application in condition for allowance because: <u>See Continuation Sheet</u> .	IOT place the
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which we raised by the Examiner in the final rejection.	ere newly
7.⊠ For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entere explanation of how the new or amended claims would be rejected is provided below or appended.	d and an
The status of the claim(s) is (or will be) as follows:	
Claim(s) allowed:	
Claim(s) objected to:	
Claim(s) rejected: <u>13-21</u> .	
Claim(s) withdrawn from consideration:	
8. The proposed drawing correction filed on is a) approved or b) disapproved by the Exa	miner.
9. Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s)	
10. Other: Skewda Four BRENDA BRUM: PATENT EXAMI	Walked BACK INFR



Applicant's arguments regarding the "burden of proof" issue (Ex parte Bhide) in the enablement analysis are noted; however, the general teachings of unpredictability which are found in the art and which were exemplified in the cited references provide such a reason for one skilled in the art to question enablement of in vivo therapy. Regarding applicant's arguments pertaining to human clinical trials, applicant is reminded that no such requirement has been made. In response to applicant's agument that the Gibbs reference is not supported by any testing data, absent some evidence to the contrary, the Gibbs reference appears to be a review of the state of the art. Numerous articles are referenced in Gibbs which do appear to be supported by testing data. Furthermore, applicant has not addressed the additional references which were cited in the enablement rejection.

Applicant's arguments regarding the metes and bounds of the recited mimic of a prenyl group are noted; however, the disclosure fails to teach what is encompassed within a mimic of a prenyl group and fails to provide guidance as to how the mimics can be made or administered. Applicant argues that a mimic of a prenyl group should behave as a prenyl group, but it remains unclear what defining function is to be used to determine what is encompassed within the group.